

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:)	Confirmation No.: 4424
)	
Brian Smalley, et al.)	Art Unit: 3651
)	
Serial No.: 10/523,887)	Examiner: Michael Collins
)	
Filed: September 6, 2005)	
)	
For: DISPENSING PACKAGE)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPEAL BRIEF

Sir:

This Appeal Brief is filed pursuant to 37 CFR 41.37, a Notice of Appeal having been filed on May 17, 2010.

I. REAL PARTY IN INTEREST

The real party in interest is the assignee, Graphic Packaging International, Inc.

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF CLAIMS

Claims 1-2, 4, 6, 9, and 60-77 are pending. Claims 3, 5, 7-8, and 10-59 are canceled. Claims 67-69, 74, and 77 are allowed and are pending in the present application, but are not subject to the instant appeal. The final rejection of claims 1-2, 4, 6, 9, 60-66, 70-73, and 75-76 dated January 21, 2010 is being appealed.

IV. STATUS OF AMENDMENTS

An After Final Amendment dated April 13, 2010 was apparently entered by the Examiner.¹ No other Amendments have been filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claims 1 and 64 read on the specification and drawings of the application as follows:

Claim	Disclosure of S.N. 10/523,887
1. A paperboard carton for articles arranged in an end-on-end relationship, the carton comprising: six sides, the six sides including a first side disposed between a second side and a third side, the first side being perpendicular a fourth side, the second side, and the third side, the second side and the third side being parallel,	FIGS. 2-8 and 11 show a paperboard carton 12 for articles 31 arranged in an end-on-end relationship. The carton 12 comprises six sides, including a first side 15 disposed between a second side 13 and a third side 16 . The first side 15 is perpendicular to a fourth side (formed by closure of the end flaps--the carton is disposed on the fourth side in FIGS. 7, 8, and 11), the second side 13 , and the third side 16 . The second side 13 and third side 16 are parallel. (see page 3, lines 8-17) ²
a two-piece dispenser that includes a first portion and a second portion; the first portion defined at least partially along its perimeter by a first tear line; the first portion extending at least partially into the first side, the second side, and the third side; the first portion being removable from the carton along the first tear line to create a first opening for article removal, the second portion being adjacent the first portion and being defined at least partially along its perimeter by the first tear line, a first provision, and a second provision;	FIGS. 9-11 show a two-piece dispenser that includes a first portion 33 and second portion 28a . The first portion 33 is defined at least partially along its perimeter by a first tear line 25 . The first portion extends at least partially into the first side 15 , the second side 13 , and the third side 16 . The first portion 33 is removable along the first tear line 25 to create a first opening. The second portion 28a is adjacent the first portion 33 and is defined at least partially along its perimeter by the first tear line 25 , and by first and second provisions (cuts 42 , shown in detail in FIG. 10). For additional detail, see page 3, lines 21-27 and page 5, lines 1-12.

¹ The Advisory Action mailed May 6, 2010 checked a box indicating "The request for reconsideration has been considered but does NOT place the application in condition for allowance."

² The citations are to the specification of the 371 application as filed.

Claim	Disclosure of S.N. 10/523,887
<p>the first provision having a first end proximate the first portion and a second end distal the first portion, the second end of the first provision being intersected by a first intersection line that prevents the first provision from extending beyond its intended length;</p> <p>the second provision having a first end proximate the first portion and a second end distal the first portion, the second end of the second provision being intersected by a second intersection line that prevents the second provision from extending beyond its intended length;</p> <p>the second portion being separable along the first provision and the second provision to create a second opening in the carton; and</p> <p>wherein the second opening and the first opening together define an enlarged opening, the enlarged opening enabling easier article removal from the carton than the first opening alone.</p>	<p>As shown in FIGS. 9-11, first and second provisions (cuts 42) have first ends proximate the first portion 33 and second ends distal the first portion 33. The second ends of the first and second provisions (cuts 42) are intersected by first and second intersection lines (transverse cuts 43 as shown in FIGS. 9 and 10) that prevent the first and second provision from extending beyond their intended lengths (page 5, lines 13-24).</p> <p>The second portion 28a is separable along first and second provisions (cuts 42) to create a second opening in the carton 12 (shown as the space where portion 28a has hinged downward in FIG. 11).</p> <p>The first and second openings together define an enlarged opening which enables easier article removal from the carton (FIG. 11, citation below).</p> <p>Instead of the entire stop wall 28 being fixed relative to the now upright base and top panels 16, 13, the now upper part 28a of the stop wall 28 is able to flex outwardly as illustrated in FIG. 11. The lower part 28b of the stop wall 28 remains fixed relative to the base and top panels 16, 13. This outward flexing of the upper part 28a is made possible by the provision of the cuts 42 in the folds 40, 41 and makes it easier to remove the cans from the carton. The transverse cuts 43, which are optional, tend to prevent the cuts 42 from extending beyond their intended length towards the side end flap 20. (page 5, lines 16-24)</p>
<p>64. A package comprising: a plurality of articles; a paperboard carton for enclosing the plurality of articles in rows, the carton comprising: six sides, the six sides including a first side disposed between a second side and a third side, the first side being perpendicular a</p>	<p>FIGS. 2-8 and 11 show a package comprising a plurality of articles 31, and a paperboard carton 12 for enclosing the plurality of articles 31 in rows. The carton 12 comprises six sides, including a first side 15 disposed between a second side 13 and a third side 16. The first side 15 is perpendicular to a fourth side (formed by closure of the end flaps--the carton is disposed on the fourth side in FIGS. 7, 8, and 11), the second side 13, and the third side</p>

Claim	Disclosure of S.N. 10/523,887
fourth side, the second side, and the third side, the second side and the third side being parallel,	16. The second side 13 and third side 16 are parallel. (see page 3, lines 8-17) ³
<p>a two-piece dispenser that includes a first portion and a second portion;</p> <p>the first portion defined at least partially along its perimeter by a first tear line;</p> <p>the first portion extending at least partially into the first side, the second side, and the third side;</p> <p>the first portion being removable from the carton along the first tear line to create a first opening for article removal,</p> <p>the second portion being adjacent the first portion and being defined at least partially along its perimeter by the first tear line, a first provision, and a second provision;</p>	<p>FIGS. 9-11 show a two-piece dispenser that includes a first portion 33 and second portion 28a. The first portion 33 is defined at least partially along its perimeter by a first tear line 25.</p> <p>The first portion extends at least partially into the first side 15, the second side 13, and the third side 16.</p> <p>The first portion 33 is removable along the first tear line 25 to create a first opening. The second portion 28a is adjacent the first portion 33 and is defined at least partially along its perimeter by the first tear line 25, and by first and second provisions (cuts 42, shown in detail in FIG. 10).</p> <p>For additional detail, see page 3, lines 21-27 and page 5, lines 1-12.</p>
<p>the first provision having a first end proximate the first portion and a second end distal the first portion,</p> <p>the second end of the first provision being intersected by a first intersection line that prevents the first provision from extending beyond its intended length;</p> <p>the second provision having a first end proximate the first portion and a second end distal the first portion,</p> <p>the second end of the second provision being intersected by a second intersection line that</p>	<p>As shown in FIGS. 9-11, first and second provisions (cuts 42) have first ends proximate the first portion 33 and second ends distal the first portion 33. The second ends of the first and second provisions (cuts 42) are intersected by first and second intersection lines (transverse cuts 43 as shown in FIGS. 9 and 10) that prevent the first and second provision from extending beyond their intended lengths (page 5, lines 13-24).</p> <p>The second portion 28a is separable along first and second provisions (cuts 42) to create a second opening in the carton 12 (shown as the space where portion 28a has hinged downward in FIG. 11).</p> <p>The first and second openings together define an</p>

³ The citations are to the specification of the 371 application as filed.

Claim	Disclosure of S.N. 10/523,887
<p>prevents the second provision from extending beyond its intended length; the second portion being separable along the first provision and the second provision to create a second opening in the carton; wherein the second opening and the first opening together define an enlarged opening, and the enlarged opening enabling easier article removal from the carton than the first opening.</p>	<p>enlarged opening which enables easier article removal from the carton (FIG. 11, citation below).</p> <p>Instead of the entire stop wall 28 being fixed relative to the now upright base and top panels 16, 13, the now upper part 28a of the stop wall 28 is able to flex outwardly as illustrated in FIG. 11. The lower part 28b of the stop wall 28 remains fixed relative to the base and top panels 16, 13. This outward flexing of the upper part 28a is made possible by the provision of the cuts 42 in the folds 40, 41 and makes it easier to remove the cans from the carton. The transverse cuts 43, which are optional, tend to prevent the cuts 42 from extending beyond their intended length towards the side end flap 20. (page 5, lines 16-24)</p>

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- Whether claims 1, 6, 9, 60-66, 70-73, and 75-76 are anticipated by *Hoy et al.* (U.S. Patent No. 5,878,947) under 35 U.S.C. § 102(b);
- Whether claims 2 and 4 are unpatentable over *Hoy et al.* under 35 U.S.C. § 103(a).

VII. ARGUMENT

This appeal is from the final rejection dated January 21, 2010.

- The rejection of claims 1, 6, 9, 60-66, 70-73, and 75-76 as being anticipated by *Hoy et al.* under 35 U.S.C. § 102(b) should be withdrawn.**

The rejection of claims 1, 6, 9, 60-66, 70-73, and 75-76 as being anticipated by *Hoy et al.* under 35 U.S.C. § 102(b) should be withdrawn. Claims 1 and 64 recite that “the first portion [of the two-piece dispenser] being removable from the carton.” Since *Hoy et al.* fails to provide a portion that is removable from the carton, *Hoy et al.* cannot be found to anticipate⁴ independent claims 1 or 64, or the claims that depend therefrom. The Examiner references stop 56 as being

⁴ To anticipate a claim, a reference must teach each and every element of the claims. MPEP 706.02(a)(IV) and MPEP 2131.

removable from the carton, but *Hoy et al.* entirely fails to teach or show in the specification or figures that stop 56 is removed or removable from his carton. As is clearly shown in Figs. 2 and 7 of *Hoy et al.*, the stop 56 remains attached to the carton so that it can perform its function of stopping the cans as they roll out of the carton. In fact, *Hoy et al.* recites in claim 2 (col. 4, lines 6-11):

“...a triangular stop formed by a center strip [62] **hingedly connected** to the bottom closure flap [38] and a pair of flaps [58, 60] **hingedly connected** to the center strip and interconnected at their outer ends [68, 70] to form a triangular brace for the center strip.” (**emphasis added**)

The Examiner attempted to justify anticipation rejections based on *Hoy et al.* in the Advisory Action dated May 6, 2010, by specifying:

However, the structure of the paperboard carton in claim 1 is being examined and the prior art device of *Hoy et al.* disclose a paperboard carton with a structure that is the same as the Applicants’ current version of claim 1 because stop 56 is structured to be removable (see the perforations in Figure 1) regardless of its purpose in the teaching according to *Hoy et al.* Therefore, *Hoy et al.* does anticipate the claim and this argument is not convincing.

This reasoning is inadequate to support an anticipation rejection based on *Hoy et al.* which does not teach or suggest removal or removability of the stop 56. The Examiner’s reference to FIG. 1 of *Hoy et al.* as showing that stop 56 could be removed from the carton of *Hoy et al.* is not supported by the blank shown in FIG. 4 or by the specification. In fact, it appears from FIG. 4 (as well as FIGS. 5 and 6) that there are tear lines on three sides of each of strips 58, 60, but that there is a fold line on the fourth side (the side to the right in FIG. 4), so that the strips can be folded relative to strip 62. In order to be anticipated, *Hoy et al.* would have to have shown tear lines in lieu of the fold lines clearly indicated in FIGS. 1-2 and 5-7. Since *Hoy et al.* shows fold lines that are hingedly connected, the strip 62 is not removable from the carton as claimed. Accordingly, the Examiner’s position that FIG. 1 shows tear lines along which stop 56 could be

removed is incorrect. At best, the Examiner could reference that FIG. 4 of *Hoy et al.* fails to show fold lines, rendering the reference unclear. If the reference is however unclear (Applicant believes *Hoy et al.* is clear, and clearly shows fold lines), *Hoy et al.* cannot be the basis for an anticipation rejection (*In re Lind*, 264 F.2d 914, 916, 121 USPQ 222, 223 (CCPA 1959) (“the disclosure of a reference must be clear to ‘anticipate’”); see also *In re Turley*, 304 F.2d 893, 899, 134 USPQ 355, 360 (CCPA 1962) (“It is well established that an anticipation rejection cannot be predicated on an ambiguous reference”)). In the instant application, independent claims 1 and 64 were only rejected as being anticipated by *Hoy et al.*⁵

Accordingly, since *Hoy et al.* does not teach every element and cannot anticipate independent claims 1 and 64, the rejections under 35 U.S.C. 102(b) based on *Hoy et al.* should be withdrawn. Also, in addition to providing distinct allowable elements themselves, claims 6, 9, 60-63, 65-66, 70-73, and 75-76 should be allowed as dependent on allowable independent claims 1 or 64, and as inheriting their allowable characteristics. Further, in addition to the reasons provided below, claims 2 and 4 should be allowed as dependent on allowable independent claim 1, and as inheriting its allowable characteristics.

2. The rejection of claims 2 and 4 as being unpatentable over *Hoy et al.* under 35 U.S.C. § 103(a) should be withdrawn.

The rejection of claims 2 and 4 as being unpatentable over *Hoy et al.* under 35 U.S.C. § 103(a) should be withdrawn at least because (1) *Hoy et al.* fails to teach or suggest each and every element and (2) if the stop 56 of *Hoy et al.* were removed as proposed by the Examiner, the resulting carton would be rendered unsatisfactory for its intended purpose of providing a

⁵ Independent claims 1 and 64 were not rejected under 35 U.S.C. § 103(a). However, even if an obviousness rejection were applied to independent claims 1 and 64, none of the specification, intended functionality and purpose, or principle of operation of the stop 56 of *Hoy et al.* would support a rejection based on obviousness for at least the reasons discussed below.

dispensing feature with a retaining means to retain one can at a time and would change the principle of operation of *Hoy et al.*

(1) As discussed above, *Hoy et al.* fails to teach or suggest each and every element of independent claim 1, which specifies that “the first portion being removable from the carton.” The Examiner references FIG. 7 and stop 56 of *Hoy et al.* as being removable from the carton. However, stop 56 is not removed or removable from the carton of *Hoy et al.* as discussed above. In fact, as shown in the blank of FIG. 4 of *Hoy et al.*, the stop does not include perforations or other tear initiation structure that would enable removal of the stop 56 or any other portion of the carton of *Hoy et al.* Stop 56 is specifically provided to retain the cans in tray 50, and, if stop 56 were intended to be removed from the carton, strips 58 and 60 would be delineated by tear lines entirely thereacross, to the periphery of end flaps 30 and 32. However, *Hoy et al.* does not show tear lines extending to the periphery of end flaps 30 and 32, and since the specification of *Hoy et al.* fails to detail in any manner that stop 56 can be removed from the carton while still retaining the cans in the carton, *Hoy et al.* fails to support a rejection based on obviousness.

(2) *Hoy et al.* provides strips 58 and 60, which are intended to “provide a stop outwardly of the package to more positively retain the cans until removed one at a time” (see column 1, lines 49-52 of *Hoy et al.*). The stop 56 of *Hoy et al.* cannot be removed from the carton without rendering *Hoy et al.* unsatisfactory for its intended purpose of providing a dispensing feature with a retaining means to retain one can at a time (column 1, lines 53-62) (see MPEP 2143.01 (V), which specifies that rendering the prior art unsatisfactory for its intended purpose fails to support a case for obviousness). Further, modifying *Hoy et al.* to remove the stop would change the principle of operation of *Hoy et al.*, since the cans would be able to roll out of the carton without being retained, contrary to a stated purpose of *Hoy et al.* (see column 1,

line 65 through column 2, line 6) (see also MPEP 2144.03(VI), which specifies that changing the principle of operation of a reference fails to support a prima facie case of obviousness). There simply is no support in *Hoy et al.* to modify *Hoy et al.* to reach the claimed invention since removing the stop 56 of *Hoy et al.* would destroy an intended functionality thereof. Accordingly, rejections based on obviousness, specifically of claims 2 and 4, should be withdrawn as unsupported and unsupportable by *Hoy et al.*

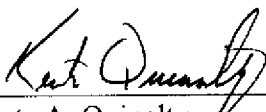
CONCLUSION

For the foregoing reasons, the subject matter of the appealed claims would not have been anticipated by or obvious to one of ordinary skill in the art over the reference applied by the Examiner in the final rejection. It is therefore respectfully requested that the final rejection of claims 1-2, 4, 6, 9, 60-66, 70-73, and 75-76 be reversed, and that all pending claims be allowed.

The Commissioner is hereby authorized to charge any fees that may be required for the timely consideration of this Appeal Brief to Deposit Account No. 09-0528.

Respectfully submitted,

7/15/10
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CLAIMS APPENDIX

1. A paperboard carton for articles arranged in an end-on-end relationship, the carton comprising:

six sides, the six sides including a first side disposed between a second side and a third side, the first side being perpendicular a fourth side, the second side, and the third side, the second side and the third side being parallel,

a two-piece dispenser that includes a first portion and a second portion; the first portion defined at least partially along its perimeter by a first tear line;

the first portion extending at least partially into the first side, the second side, and the third side;

the first portion being removable from the carton along the first tear line to create a first opening for article removal, the second portion being adjacent the first portion and being defined at least partially along its perimeter by the first tear line, a first provision, and a second provision;

the first provision having a first end proximate the first portion and a second end distal the first portion, the second end of the first provision being intersected by a first intersection line that prevents the first provision from extending beyond its intended length;

the second provision having a first end proximate the first portion and a second end distal the first portion, the second end of the second provision being intersected by a second intersection line that prevents the second provision from extending beyond its intended length;

the second portion being separable along the first provision and the second provision to create a second opening in the carton; and

wherein the second opening and the first opening together define an enlarged opening, the enlarged opening enabling easier article removal from the carton than the first opening alone.

2. The carton of claim 1 wherein a divider pad is secured to the inside of the carton.
4. The carton of claim 2 wherein the divider pad has a fold down gluing panel.
6. The carton of claim 1 wherein the first provision and the second provision are parallel.
9. The carton of claim 1 wherein the six sides are arranged substantially rectangular.
60. The carton of claim 1 wherein the first tear line defines a perimeter section of the second portion in the first side.
61. The package of claim 64 wherein the first tear line defines a perimeter section of the second portion in the first side.
62. The carton of claim 1, wherein the first and second provisions are cuts.
63. The carton of claim 1, wherein the first and second intersection lines are cuts.
64. A package comprising:
a plurality of articles;
a paperboard carton for enclosing the plurality of articles in rows, the carton comprising:

six sides, the six sides including a first side disposed between a second side and a third side, the first side being perpendicular a fourth side, the second side, and the third side, the second side and the third side being parallel,

a two-piece dispenser that includes a first portion and a second portion;

the first portion defined at least partially along its perimeter by a first tear line;

the first portion extending at least partially into the first side, the second side, and the third side;

the first portion being removable from the carton along the first tear line to create a first opening for article removal,

the second portion being adjacent the first portion and being defined at least partially along its perimeter by the first tear line, a first provision, and a second provision;

the first provision having a first end proximate the first portion and a second end distal the first portion,

the second end of the first provision being intersected by a first intersection line that prevents the first provision from extending beyond its intended length;

the second provision having a first end proximate the first portion and a second end distal the first portion,

the second end of the second provision being intersected by
a second intersection line that prevents the second provision from
extending beyond its intended length;

the second portion being separable along the first provision
and the second provision to create a second opening in the carton;

wherein the second opening and the first opening together
define an enlarged opening, and

the enlarged opening enabling easier article removal from
the carton than the first opening.

65. The package of claim 63, wherein the first and second provisions are cuts.

66. The package of claim 63, wherein the first and second intersection lines are cuts.

70. The carton of claim 1 wherein the second portion is hingeable at the first
intersection line and the second intersection line.

71. The package of claim 64 wherein the second portion is hingeable at the first
intersection line and the second intersection line.

72. The carton of claim 1 wherein the first side and the fourth side intersect at a fold
line and wherein the first intersection line and the second intersection line are spaced from the
fold line.

73. The package of claim 64 the first side and the fourth side intersect at a fold line and wherein the first intersection line and the second intersection line are spaced from the fold line.

75. The carton of claim 1 wherein the first portion is removable from the second portion.

76. The package of claim 64 wherein the first portion is removable from the second portion.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.